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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,012	09/27/2001	Giancarlo Carbone	GB920010014US1	2763
7590	06/29/2004		EXAMINER	
IBM Corp. IP Law 1140 Burnett Road, Zip 4054 Austin, TX 78758			NGUYEN BA, HOANG VU A	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/965,012	CARBONE ET AL.	
	Examiner	Art Unit	
	Hoang-Vu A Nguyen-Ba	2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/5/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to application filed September 27, 2001 claiming priority benefit of Foreign Application UK 0107321.2 filed March 23, 2001.
2. Claims 1-14 have been examined.

Drawings

3. The drawings filed September 27, 2001 are approved by the examiner.

Claim Objection

4. Claims 1, 3, 4, 8, 10, 11, 12, 13 and 14 are objected to because of the following informalities:
 - a. Claims 1(lines 5, 10), 3 (line 2), 10 (line 5), 13 (lines 8, 12), 14 (lines 5, 11) recite the limitation "the authorization." This limitation should be changed to – the execution authorization – in order to provide this limitation with clear antecedent basis.
 - b. Claims 1 (lines 7, 11), 13 (lines 5, 10) and 14 (lines 7, 10) recite the limitation "the program." This limitation should be changed to – the software program – in order to provide the limitation with clear antecedent basis.
 - c. Claims 8 (line 3), 11 (line 3) and 12 (line 2) recite the limitation "the program." This limitation should be changed to – the computer program – in order to provide the limitation with clear antecedent basis.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 4 recites the limitation "the request to a further computer" at line 3. This limitation lacks proper antecedent basis.

b. Claim 4 recites the limitation "the corresponding license certificate" at line 8. This limitation should be changed to -- the corresponding digital license certificate -- to provide this limitation with sufficient antecedent in the claim.

c. Claim 5 recites "the corresponding license certificate." It is unclear which license certificate is being referred to. For art rejection purposes, this limitation is being interpreted to mean -- local digital license certificate --.

7. Claims 8, 9, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A single claim which claims both a product and method steps of using the product is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

In claims 8 and 11, it is unclear whether a computer program or a process of controlling use of software programs is claimed. With a computer program recited in the preamble, one would expect to find in the body of the claim means or devices having functions to control the use of software programs. However, one only found method steps for controlling use of software programs.

In claims 9 and 12, it is unclear whether a program product or a computer program stored on a computer readable medium or a process of controlling use of software programs is claimed. With a program product recited in the preamble, one would expect to find in the body of the claim means or devices having functions to control the use of software programs. However, one only found method steps for controlling use of software programs.

Correction is required.

Claim Rejections – 35 USC § 101

8. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 8, 9, 11, and 12 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

A single claim which claims both a program product and the method steps of using the program product should also be rejected under 35 U.S.C. 101, *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), based on the theory that the claim is directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Correction is required.

10. Claims 13 and 14 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The invention as disclosed in claims 13 and 14 are directed to non-statutory subject matter. While the claims are in the technological arts, they are not limited to "a practical application of an abstract idea which produced a useful, concrete, and tangible result." State Street Bank & Trust v. Signature Financial Group, Inc., 149 F. 3d 1368, 1375 n. 9 (Fed. Cir. 1998).

Specifically, the claims are directed to a system for controlling use of software programs on a computer. This system comprising of a licensing management system and means for starting a bootstrap, means for granting an execution authorization and means for revising, all of which appear to be software components, e.g., software program per se. Applicants thus fail to disclose that these software components are tangibly embodied and executed by a piece of hardware and that their functions have practical applications which produce useful, concrete, and tangible results under the State Street Formulation.

On this basis, claims 13 and 14 are rejected under 35 U.S.C. § 101.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12. Claims 1-14 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,185,678 to Arbaugh et al. ("Arbaugh").

Claim 1

Arbaugh discloses at least:

starting a bootstrap involving loading at least one software program providing basic services for the computer (see at least Figure 2a and related discussion in the specification);

requesting an execution authorisation by each program to a licensing management system (see at least Figures 2b-2d, steps 266, 274, 286, 292, 298 and related discussion in the specification);

granting the authorisation according to a preliminary verification of licensing information indicative of an authorised condition of use of the program before completion of the bootstrap (see at least Figures 2b-2d, steps 266, 274, 286, 292, 298 and related discussion in the specification); and

revising the granted authorisation according to a complete verification of the licensing information after completion of the bootstrap (see at least Figures 2b-2d, steps 266, 274, 286, 292, 298 and related discussion in the specification; also see discussion on AEGIS Network Recovery Protocol, sections A, D).

Claim 2

The rejection of base claim 1 is incorporated. Arbaugh further discloses:

loading a basic module of the licensing management system before completion of the bootstrap, each authorisation being requested to and being granted by the basic module (see at least Figures 2a-2d and related discussion in the specification; also see discussion on AEGIS Network Recovery Protocol, sections A, D);

logging each request of authorization (see at least Figures 2a-2d and related discussion in the specification; also see discussion on AEGIS Network Recovery Protocol, sections A, D);

loading a full module of the licensing management system after completion of the bootstrap (see at least Figures 2a-2d and related discussion in the specification; also see discussion on AEGIS Network Recovery Protocol, sections A, D); and

providing each logged request to the full module for revising the corresponding granted authorization (see at least Figures 2a-2d and related discussion in the specification; also see discussion on AEGIS Network Recovery Protocol, sections A, D).

Claim 3

The rejection of base claim 1 and intervening claim 2 is incorporated. Arbaugh further discloses *wherein the step of requesting the authorisation is deferred until completion of the loading of the basic module* (see at least Figures 2a-2d and related discussion in the specification; also see discussion on AEGIS Network Recovery Protocol, sections A, D).

Claim 4

The rejection of base claim 1 and intervening claim 2 is incorporated. Arbaugh further discloses:

sending a message indicative of the request to a further computer storing a digital license certificate for each program including the corresponding licensing information (see at least Figures 2a-2d and related discussion in the specification; also see discussion on AEGIS Network Recovery Protocol, sections A, D); and

verifying compliance of the request with the corresponding licence certificate (see at least Figures 2a-2d and related discussion in the specification; also see discussion on AEGIS Network Recovery Protocol, sections A, D).

Claim 5

The rejection of base claim 1 and intervening claims 2, 4 is incorporated. Arbaugh further discloses *wherein the step of granting the authorisation includes verifying a local digital license certificate stored on the computer and including a simplified copy of the corresponding license certificate* (see at least Figures 2a-2d and related discussion in the specification; also see discussion on AEGIS Network Recovery Protocol, sections A, D).

Claim 6

The rejection of base claim 1 and intervening claims 2, 4, 5 is incorporated. Arbaugh further discloses *the step of updating each local license certificate according to a new version thereof received from the further computer after completion of the bootstrap* (see at least Figures 2a-2d and related discussion in the specification; also see discussion on AEGIS Network Recovery Protocol, sections A, D).

Claim 7

The rejection of base claim 1 is incorporated. Arbaugh further discloses:
monitoring operation of the computer for detecting a change in an execution environment of each program (see at least Figures 2a-2d and related discussion in the specification; also see discussion on AEGIS Network Recovery Protocol, sections A, D); and
revising the corresponding granted authorization according to the detected change (see at least Figures 2a-2d and related discussion in the specification; also see discussion on AEGIS Network Recovery Protocol, sections A, D).

Claim 8

Since claim 8 recites *a computer program directly loadable into a working memory of a computer for performing* the same method steps of claim 1, the same rejection is applied.

Claim 9

Since claim 9 recites *a program product including a computer readable medium on which the computer program of claim 8 is stored*, this computer program performing the same method steps of claim 1, the same rejection is applied.

Claim 10

Since claim 10 recites the same method steps of claims 1 and 7, the same rejections are applied.

Claim 11

Since claim 11 recites *a computer program directly loadable into a working memory of a computer for performing* the same method steps of claim 10, the same rejection is applied.

Claim 12

Since claim 12 recites *a program product including a computer readable medium on which the computer program of claim 11 is stored*, this computer program performing the same method steps of claim 10, the same rejection is applied.

Claim 13

Since claim 13 recites a system comprising the same method steps of claim 1, the same rejection is applied.

Claim 14

Since claim 14 recites a system comprising the same method steps of claims 1 and 7, the same rejections are applied.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu A Nguyen-Ba whose telephone number is (703) 305-0103. The examiner can normally be reached on Tuesday-Friday, 6:00 – 16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ANTONY NGUYEN-BA
PRIMARY EXAMINER**

Art Unit 2122

June 24, 2004